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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,347	08/29/2001	Lance Kyle Lipscomb	CL/V-31575A	7097

7590

08/26/2003

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EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/942,347

Applicant(s)

LIPSCOMB ET AL.

Examiner

Greg Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This Office action acknowledges the applicant's Amendment A, presented as Paper No. 7. Claims 1-7 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on June 2, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Specification***

4. In light of the applicant's amendment, the objection to the specification is hereby withdrawn.

### ***Claim Objections***

5. Claims 2, 3, 5 and 7 are objected to because of the following informalities: The claims recite the term "Chamille No." to measure roughness. The examiner believes

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this is a misspelling and that the applicant is referring to a "Charmille No." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant's amendment removes the number of the claim on which the claim depends, rendering the claim indefinite.

### ***Claim Rejections - 35 USC § 103***

7. Due to the priority claim of the applicant, specifically concerning reference US 6,050,398, the rejection of claims 1-4 under 35 U.S.C. 103(a) is hereby withdrawn.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4-6 of Wilde et al (US 6,050,398) in view of Abrams et al (US 5,467,868).

Regarding claims 1 and 4, Wilde et al (claims 1 and 4) disclose the claimed invention except for the roughness of the bowl portion.

Abrams et al discloses a container for contact lenses with a base portion (10) and a bowl portion (12), wherein the bowl portion has a roughness of less than 800 grit (Col. 3, ll. 34-38). The examiner interprets the sliding feature discussed by Abrams et al as maintaining capillary attraction without adhesion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Wilde et al with a roughened bowl as taught by Abrams et al in order to allow the lens to slide against the interior surface for removal with the finger.

As to claims 2 and 3, the container of Wilde-Abrams discloses a roughness of less than 800 grit. Charmille Numbers in the range of 16 to 30 equate to approximately 0.56 to 3.15 RMS (microns) respectively. 0.56 RMS (microns) approximately equates to 220 grit, while 3.15 RMS (microns) approximately equates to 50 grit. Therefore, the container of Wilde-Abrams anticipates the ranges claimed by the applicant. It has been held that where the general conditions of a claim are disclosed in the prior art,

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discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 5 and 6, Wilde et al (claims 5 and 6) disclose the claimed invention except for the roughness of the bowl portion.

Abrams et al discloses a container for contact lenses with a base portion (10) and a bowl portion (12), wherein the bowl portion has a roughness of less than 800 grit (Col. 3, ll. 34-38). The examiner interprets the sliding feature discussed by Abrams et al as maintaining capillary attraction without adhesion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Wilde et al with a roughened bowl as taught by Abrams et al in order to allow the lens to slide against the interior surface for removal with the finger. The container of Wilde-Abrams discloses a roughness of less than 800 grit. Charmille numbers in the range of 16 to 30 equate to approximately 0.56 to 3.15 RMS (microns) respectively. 0.56 RMS (microns) approximately equates to 220 grit, while 3.15 RMS (microns) approximately equates to 50 grit. Therefore, the container of Wilde-Abrams anticipates the ranges claimed by the applicant. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As to claim 7, the examiner assumes the claim to depend from claim 5 and as such, the container of Wilde-Abrams anticipates the ranges claimed by the applicant.

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***Response to Arguments***

9. Applicant's arguments, see pages 4-5 of Paper No. 7, filed June 2, 2003, with respect to the applicability of Poler, have been fully considered and are persuasive. The rejection of claims 1-4 under 35 U.S.C. 103(a) has been withdrawn.

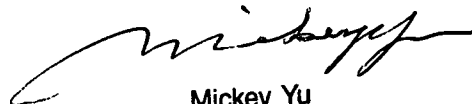
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

*GPP*  
Gregory Pickett  
Examiner  
August 12, 2003

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700